

REMARKS

Summary:

In the Final Office Action dated August 25, 2008, claims 1, 5-7, 11, 13, 16, 25, and 31-33 were rejected under 35 U.S.C. § 102(b) as anticipated by *Walsh '871* (U.S. Patent 5,746,871), claims 9-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Walsh '871* in view of *Decottignies, et al.* (U.S. Patent No. 5,097,651), claims 2, 14-15, and 26-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Walsh '871* in view of *McNown* (U.S. Patent No. 5,447,270), claims 1, 3-7, 11, 13-15, 25-29, and 31-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Claff* (U.S. Patent 2,008,608) view of *McNown*, and claims 9-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Claff* in view of *McNown* and further in view of *Lang* (U.S. Patent No. 5,147,480).

Upon entry of the present Amendment, claims 1 and 25 will have been amended, claims 4, 8, 12, 16-24, 30, and 34-76 will have been canceled, claims 77-81 will have been added, and claims 1-3, 5-7, 9-11, 13-15, 25-29, 31-33, and 77-81 will be pending in the application.

Inadequacy of Final Rejection Under MPEP § 707.07:

The Final Rejection mailed August 25, 2008 should be withdrawn as failing to respond, as required, to each and every traversal of the rejections applied. Specifically, Applicant filed a response dated July 14, 2008 that included traversals of rejections applied to the claims that were not addressed in the Final Rejection. Since the Examiner cannot make an Office Action final without properly addressing each and every traversal asserted by the Applicant as outlined in MPEP § 707.07(f), the Final Rejection must be withdrawn and the present Amendment Under 37 C.F.R. § 1.116 should be entered and considered. MPEP § 707.07(f) specifies:

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear

explanations of all actions taken by the examiner during prosecution of an application.

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

The Examiner entirely failed to address a multitude of arguments asserted in the Amendment filed July 14, 2008, including traversals of rejections based on (1) the failure of *Walsh '871* to disclose explicitly that the first ribbon and the second ribbon do not extend across the longitudinal fold lines, (2) the failure of *Walsh '871* to disclose inherently that the first ribbon and the second ribbon do not extend across the longitudinal fold lines, (3) *Claff*--numerous traversals of rejections based on *Claff* as a base reference were provided. None of these traversals were addressed in the Final Rejection issued August 25, 2008. Since the Final Rejection is inadequate on its face as failing to address with specificity numerous traversals of the rejections asserted by the Examiner as required by MPEP § 707.07, the Final Rejection must be withdrawn, and the present Amendment must be entered and considered.

For the convenience of the Examiner, the traversals of the rejections based on *Walsh '871*, *McNown*, *Decottignies*, *Claff*, and *Lang* as presented in the Amendment dated July 14, 2008 are repeated here:

RESPONSE TO REJECTIONS BASED ON *WALSH '871*

(1) **Anticipation by *Walsh '871***

Claims 1, 5-7, 11, 13, 25 and 31-33 were rejected as anticipated by *Walsh '871* under 35 U.S.C. § 102(b). Applicant submits that *Walsh '871* does not anticipate independent claims 1

and 25, and, it follows, the claims dependent thereon, because *Walsh* '871 does not disclose all the limitations recited in claims 1 and 25.

Comparing the disclosure of *Walsh* '871 to claims 1 and 25, *Walsh* '871 discloses a method of making paperboard cartons from a web of paperboard 2, which is shown in Fig. 2 as being the width of two carton blanks. Strips 6 of relatively flexible material, such as kraft paper (col. 2, lines 54-58), are positioned at spaced apart locations across the web. Also, longitudinal fold lines, such as the horizontal fold lines 54 shown in Fig. 5 of *Walsh* '871, define between them panel portions, each of which becomes a plurality of panels 56, 58, 60. These panel portions correspond to the "longitudinally extending panel portions" recited in claims 1 and 25. The web and ribbons are cut at 66 to form carton blanks.

However, *Walsh* '871 does not disclose at least the following limitations of claims 1 and 25:

- (A) Claims 1 and 25 each recite in step (b) that the first and second ribbons overlie and adhere to, or are positioned on and adhered to, longitudinally extending panel portions of the web. *Walsh* '871 does not meet this limitation because ribbons 6 are not adhered to the portions of the web 2 which they overlie or are positioned on. Rather, *Walsh* '871 discloses applying adhesive 22 only to the flexible plastic film 10 which covers the web 2 and strips 6 (see Fig. 1) so that, as disclosed at col. 3, lines 5-11, strips 6 are secured to film 10, and the portions of the web 2 between the strips 6 are secured to film 10. As shown in Figs. 3, 7, 10 and 12, adhesive 22 is located between strips 6 and film 10, but no adhesive is located between strips 6 and web 2.
- (B) Claims 1 and 25 also recite in step (b), respectively (emphasis added):

... the first ribbon being positioned to overlie and adhere to substantially all of, but not beyond, a first selected longitudinally extending panel portion of the web, and the second ribbon being positioned to overlie and adhere to substantially all of, but not beyond, a second selected longitudinally extending panel portion of the

web, the first ribbon and the second ribbon not extending across the longitudinal fold lines;

and

... the first ribbon being positioned on, and adhered to, substantially all of, but not beyond, a first longitudinally extending panel portion of the web of noncorrugated paperboard, and a second ribbon being positioned on, and adhered to, substantially all of, but not beyond, a second longitudinally extending panel portion of the web, the first ribbon and the second ribbon not extending across the longitudinal fold lines;

The Examiner seems to assume that the ribbons 6 of *Walsh '871* do not extend across horizontal fold lines 54, and therefore that the underlined limitations are anticipated. However, Applicant can find no express or explicit disclosure in *Walsh '871* either that the ribbons (strips) 6 do not extend across the horizontal fold lines 54, and/or that, for example, the bottom ribbon 6 shown in Fig. 2 is narrower than the distance between the lowest horizontal score line 54 and the bottom edge of the carton blank of Fig. 5 (i.e., that bottom ribbon 6 is narrower than panels 58), so that the bottom ribbon would not extend across the lowest score line 54.

“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). In the present case, since *Walsh '871* does not explicitly disclose the underlined limitations, any finding of anticipation must be based on inherency. However, “[i]nherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” Trintec Industries, Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002) (citing In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). Since it is at least possible that the ribbons 6 of *Walsh '871* extend across the horizontal fold lines 54, *Walsh '871* does not inherently anticipate the underlined limitations.

Moreover, it is noted that Figs. 2 and 5 of *Walsh '871* are not on the same scale, since the width of web 2, shown in Fig. 2, which is the width of two carton blanks (col. 3, lines 27-30), is not twice the height of the carton blank shown in Fig. 5. If Fig. 2 is enlarged so that web 2 is twice the width of the carton blank of Fig. 5, as shown below, it can be seen that the width of the edge strips 6 is greater than the width of the edge panels 56, 58 in Fig. 5, and the width of the center strip 6 is more than twice the width of the edge panels 56, 58. Thus, to the extent that any information can be gleaned from the drawings of *Walsh '871*, it appears that strips (ribbons) 6 would extend from the edges of the carton of Fig. 5 across the horizontal (longitudinal) fold lines 54.

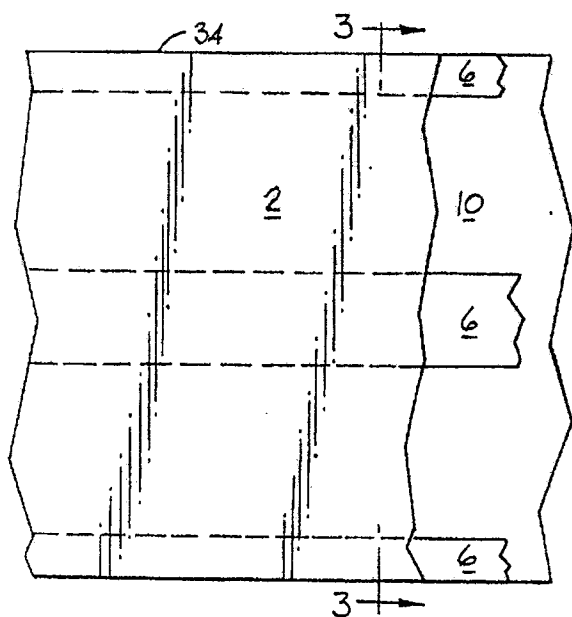


FIG 2

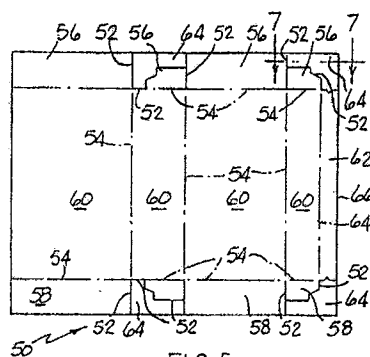


FIG. 5

Accordingly, since *Walsh '871* does not expressly or inherently disclose all the limitations of claims 1 and 25, and, it follows, of claims 5-7, 11, 13 and 31-33 dependent thereon, the rejection of those claims as anticipated by *Walsh '871* should be withdrawn.

(2) **Walsh '871 In View of Decottignies**

Claims 9 and 10 were rejected as unpatentable over *Walsh '871* in view of *Decottignies*, under 35 U.S.C. § 103(a). This rejection is traversed for at least the following reasons:

As discussed above, *Walsh '871* does not disclose, expressly or inherently, all the limitations of parent claims 1 and 25. The Examiner cites *Decottignies* as evidence that it would have been obvious to print indicia on the strips 6 of *Walsh '871*. However, whatever may be the merits of this position, *Decottignies* does not disclose or render obvious the limitations of parent claim 1 which, as discussed above, are not disclosed by *Walsh '871*. The rejection therefore should be withdrawn.

(3) **Walsh '871 In View of McNown**

Claims 2, 14, 15 and 26-28 were rejected as unpatentable over *Walsh '871* in view of *McNown*, under 35 U.S.C. § 103(a). This rejection is traversed for the following reasons:

- (A) *McNown* does not overcome the deficiencies in *Walsh '871* as discussed above with respect to parent claims 1 and 25.
- (B) The rejected claims require that at least one of the ribbons comprises paperboard. *Walsh '871* discloses that the strips (ribbons) 6 are made “of a relatively flexible material, such as kraft paper” (col. 2, lines 55 and 56), whereas the web 2 is made “of a relatively rigid material, such as paperboard” (col. 2, lines 53 and 54). The relative flexibility of the strips 6 in *Walsh '871* is necessary in order for the strips to function as the patentee intended, namely to form a barrier between the rigid paperboard material 2 and the continuous film 10 of relatively flexible fluid impervious material to allow (i) the rigid material 2 to be cut along cut lines without piercing the film 10 while still allowing (ii) flexibility to fold the blank into a carton. These functions would be negated if the strips 6 were made of paperboard.

Accordingly, it would not have been obvious to modify *Walsh* '871 in view of *McNown* by making the strips 6 of *Walsh* '871 out of the same "relatively rigid material," i.e., paperboard, as the web 2, since to do so would render *Walsh* '871 unsuitable for its intended purpose and would change the principle of operation of *Walsh* '871, both of which are improper; see MPEP 2143.01(V) and (VI).

RESPONSE TO REJECTIONS BASED ON *CLAFF*

(4) *Claff* In View of *McNown*

Claims 1, 3, 5-7, 11, 13-15, 25-29 and 31-33 were rejected as unpatentable over *Claff* in view of *McNown*, under 35 U.S.C. § 103(a). This rejection is traversed for at least the following reasons:

The Examiner acknowledges that the ribbons 2 of *Claff* extend over the bottom edge fold line (6), citing col. 2, lines 30-37, where *Claff* states (numerals in brackets added):

The tape [2] used is of a width greater than the height of the walls of the box to be made so that there will be enough material in each tape not only to cover the outer surface of the reinforced wall [3] but also to extend a short distance along the bottom of the box [8] at one edge [4] while the other edge portion [5] of the tape can be folded over the free top or longitudinal edge of the wall.

Thus, since the longitudinally extending panel portions of the web 1 of *Claff* which correspond to the walls and bottom panel 8 of the carton are separated by longitudinal fold lines 6, and the ribbons extend over these fold lines, as shown in Figs. 1, 2 and 4, *Claff* does not meet the limitations in step (b) of claims 1 and 25 that each of the first and second ribbons adhere to "substantially all of, but not beyond," longitudinally extending panel portions, and do not extend across the longitudinal fold lines.

However, in spite of these differences between the claimed subject matter and *Claff*, the Examiner finds that the claims would have been obvious in view of *McNown*, stating at page 5 of the Office action:

McNown however in addition to directly reinforcing fold/score lines teaches aligning reinforcing strips along fold/score lines for reinforcing selected panel portions (including an intermediate); see figures 1a-1c. It would have been obvious to one of ordinary skill in the art at the time of the invention to include positioning reinforcing strips along the fold lines in the invention to *Claff* in order to sufficiently increase the structural integrity with reduced cost.

McNown discloses that a box may be reinforced by laminating paperboard strips (ribbons) 4 thereto. Insofar as understood, *McNown* discloses two arrangements of laminating the strips 4: either (i) across the flap score lines 6 (Figs. 1b, 4a, 4b), or (ii) inside the score lines 6 (Figs. 1c, 5a, 5b). Since arrangement (i) would not meet the limitation of claims 1 and 25 that the ribbons do not extend across the longitudinal fold lines, the Examiner is apparently relying on *McNown*'s disclosure of arrangement (ii). It is not clear whether the Examiner considers that it would have been obvious to substitute the laminations 4 of *McNown*'s arrangement (ii) for the tapes 2 of *Claff*, or simply to add *McNown*'s arrangement (ii) laminations 4 to *Claff*, but, in either case, the combination of *Claff* and *McNown* would not render the subject matter of claims 1 and 25 unpatentable, for at least the following reasons:

(A) If it is the Examiner's position that it would have been obvious, in view of *McNown*, to substitute *McNown*'s laminations for the reinforcing tapes 2 of *Claff*, Applicant respectfully disagrees. *Claff* positions tapes 2 over the score lines 6 and walls 3 in order to reinforce the walls (page 1, col. 2, lines 37-43; page 2, col. 1, lines 29-37) and corners (page 1, col. 1, lines 35-38), as well as to reduce tearing at slots 11 (page 2, col. 1, lines 22-28). However, if the *Claff* arrangement were modified in view of *McNown*'s arrangement (ii), by substituting laminations inside the score lines 6 of *Claff* (in areas 4) for *Claff*'s tapes 2, all these functions and advantages

would be negated. One of ordinary skill would therefore not have been motivated to combine *Claff* and *McNown*.

(B) On the other hand, assuming that one of ordinary skill in the art would have been motivated to modify *Claff* in view of *McNown*'s arrangement (ii), reinforcing strips would be laminated to *Claff*'s web 2 inside score lines 6, i.e., in the areas numbered 4 in *Claff*'s Fig. 1. The strips would not be laminated to *Claff*'s flaps (walls) 3 in view of *McNown*'s express disclosure, repeated in Fig. 1c, and at col. 2, lines 47 and 57; col. 3, lines 8, 37 and 38; col. 4, line 46; and col. 5, line 1, that the laminations are "inside" or "just inside" the score lines. However, modifying *Claff* by laminating reinforcing strips in the areas 4 just inside *Claff*'s longitudinal score lines 6, either substituted for or added to *Claff*'s tapes 2, would not meet claims 1 or 25 because each of those claims requires that there be first and second ribbons which overlie, or are positioned on, and are adhered to "substantially all of, but not beyond," first and second longitudinally extending panel portions of the web, respectively. By contrast, in *Claff* as modified by *McNown*, there would be two ribbons on a single longitudinally extending panel portion 8 of the web, and neither ribbon would overlie or be positioned on, and adhered to, "substantially all" of the panel portion.

(5) ***Claff In View of McNown and Lang***

Claims 9 and 10 were rejected as unpatentable over *Claff* in view of *McNown* and further in view of *Lang*, under 35 U.S.C. § 103(a). This rejection is traversed for at least the following reasons:

The Examiner cites *Lang* as evidence that it would have been obvious to include printing on *Claff*'s reinforcing strips. However, inasmuch as *Lang* does not address the deficiencies

discussed above with regard to the combination of *Claff* and *McNown*, claims 9 and 10 are patentable over the applied prior art for the same reasons as their parent claim 1.

Remarks Regarding *Smith*

In connection with the claimed invention, Applicant wishes to call the Examiner's attention to *Smith* (U.S. Patent 1,762,703). *Smith* was cited in the Information Disclosure Statement that was filed on May 12, 2008, and considered by the Examiner (initialed) on August 21, 2008. However, *Smith* has not been applied in rejecting any claims in this application. Although the examiner is urged to consider *Smith* in detail for himself, for his convenience, the following is provided as an overview of parts of *Smith* that Applicant believes most relevant to the presently claimed invention.

Smith discloses a box blank B² and method of making a box therefrom. As shown in the figures (e.g., Figs. 10 and 25) and as detailed in the specification of *Smith*, the box formed from the blank includes a bottom panel and two side panels, but does not include a top panel. As shown in Figs. 15-21 and described on page 7, line 121 through page 8, line 109, box shell material 1 receives reinforcing strips 60 on a surface that will become an outer surface side of the box shell. The reinforcing strips are applied over a web of box shell material 1, and a cover or finishing material 3 is applied thereover. As shown in Figs. 20 and 21, reinforcing strips 60 can be applied over fold line 20, or up to fold line 20a. However, when formed into a box, the reinforcing material and cover are disposed on an outer surface side of the box shell material, between the shell material 1 and the cover material 3.

Independent claims 1 and 25 have been amended to recite a method of making a paperboard carton having a top wall, a bottom wall, and two side walls where a first ribbon and a second ribbon of reinforcing material are applied to a web, with the first ribbon being positioned

on and adhered to substantially all of, but not beyond, a first panel portion, and the second ribbon being positioned on and adhered to substantially all of, but not beyond, a second panel portion. Neither the first ribbon nor the second ribbon extends across the longitudinal fold lines, both the first ribbon and the second ribbon reinforce the carton, and the first ribbon and the second ribbon are positioned on the inside of the carton when formed. In contrast, the box of *Smith* only includes a bottom wall and two side walls, and does not include a top wall as claimed. Further, *Smith* only teaches reinforcing the outside of the box shell and not applying reinforcement to the inside of an enclosed carton as claimed. Moreover, Applicant submits that it would not have been obvious to modify the *Smith* process by including a top carton wall or by reinforcing an interior of the enclosed carton since *Smith* fails to provide a teaching for enclosing a carton with a top wall, and fails to provide reinforcement for the interior of the carton.

Conclusion

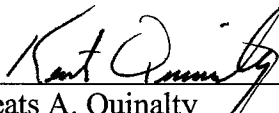
In view of the foregoing, Applicant submits that the claims now pending in the application are patentable over the cited art, and requests that the rejections be withdrawn and the application passed to issue. If any issues remain unresolved, however, Applicant's attorney would welcome a telephone conference with the Examiner in order to resolve them.

Authorization

The Commissioner is hereby authorized to charge any fees that may be required for the timely consideration of this Amendment Under 37 C.F.R. § 1.116 to Deposit Account No. 09-0528.

Respectfully submitted,

10/23/08
Date



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